

the §103 rejections asserted in the instant Office Action fails to satisfy these §103 requirements and, therefore, the rejections must be withdrawn.

The Office Action expressly acknowledges that neither the primary reference (the '413 patent) nor the main secondary reference (the '745 patent) corresponds to the claimed invention because, among other missing limitations, neither of these references includes any teaching relating to the claimed condensor aspects as set forth in the claims. Accordingly, taken alone or in combination, this asserted prior art does not correspond to the claimed invention. In an attempt to overcome this deficiency of the prior art teaching, the Office Action alleges that since condensers are known, it would be obvious for the skilled artisan to invent something that corresponds to the claimed invention (paraphrasing the Office Action discussion beginning near the bottom of page 2). In addition, the collective combination of asserted prior art teaching would not result in correspondence to the claimed invention because the claimed invention requires that the claimed condensor article "direct light into a light guide." The Office Action also admits that none of asserted reference (used to support the §103 rejections) includes a condensor that "direct[s] light into a light guide, as claimed; thus, because none of these asserted references teaches this aspect of claimed invention, it is untenable to argue that the combination of these references teaches this aspect of claimed invention and/or teaches claimed invention "as a whole."

Applicant respectfully submits that such rationale is inconsistent with 35 U.S.C. §103 and the MPEP requirements for presenting a *prima facie* argument that a patent application claim would be obvious under §103: considered "as a whole," the present invention is not taught or suggested. If such §103 rejections were permissible, the USPTO would never issue patent claims directed to a combination of known elements since, as asserted in this Office Action, each element could be found somewhere in the prior art.

Moreover, the Office Action fails to present motivation in support of the modification of the cited '413 reference. Evidence has not been provided of any teaching or suggestion for using the '413 reference in connection with a condenser lens, as claimed in the instant invention, or for modifying the reference to achieve the claimed limitations. Recent case law indicates that evidence of motivation must be specifically

identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000). The Office Action fails to identify reasons why one skilled in the art would be led to modify the '413 reference, and does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Applicant requests that the rejection be withdrawn.

Another purpose of this evidentiary requirement is to preclude prior-art rejections that are based on prior art that teaches away from the claimed invention. With respect to each of the instant rejections, the asserted prior art unquestionably teaches away from the claimed invention. The cited embodiment of the '413 reference involves use of a spot sensing assembly oriented to direct light from each of the emitters 32 to respective test spots 34. The Examiner's combination of prior art elements, however, would result in the '413 reference being modified in a manner that inhibits (or precludes) the ability to direct light from each of the emitters 32 to respective test spots 34. Because this proposed modification would thereby undermine the operation and/or intent of the '413 reference, the cited prior art establishes that skilled artisan would not be motivated as asserted in the Office Action; consequently, the prior art teaches away from the claimed invention. *See, e.g., In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (A §103 rejection cannot be maintained when the asserted modification undermines purpose of main reference.).

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Mr. Eric M. Bram, of Philips Corporation at (914) 333-9635.

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